

RESPONSE TO RESTRICTION REQUIREMENT UNDER 37 CFR §1.142

AND ELECTION OF SPECIES UNDER 37 CFR §1.146

RESTRICTION REQUIREMENT

The Examiner has required, under 35 USC §121, the election of a single disclosed invention for prosecution on the merits. The Examiner contends that although Inventions I and II are related as product and process of use, they are independent and distinct, having the same classification in the art, Class 623, but different subclasses 1.11 and 1.42, and thus require a different field of search. Status in the art is not mentioned in the Restriction Requirement.

Applicant provisionally elects to prosecute the invention designated in the Office Action as Group II (claims drawn to methods for use) with traverse. Applicant submits that new Claims 23-36 fall within Group II.

Basis For Traverse

According to MPEP § 803, a restriction requirement between patentably distinct inventions is only proper when:

- 1) The inventions are independent or distinct; and
- 2) There is a serious burden on the Examiner if restriction is not required.

A rebuttable prima facie showing of a serious burden can be made if the Examiner shows by appropriate explanation either separate classification, status in the art, or a different field of search as defined in MPEP § 808.02.

Applicant notes that to establish a rebuttable presumption of a serious burden, the Examiner must show by appropriate explanation either separate classification, status in the art, or a different field of search as defined in MPEP § 808.02. While Applicant is aware that the Examiner need not cite patents to show a different field of search, according to MPEP § 808.02, the Examiner must provide, at a minimum, an appropriate explanation to establish a rebuttable prima facie showing of a serious burden. Applicant asserts that a rebuttable prima facie showing of a serious burden has not been established because: 1) both the product and the process for using the product are in the same class (623), and 2) although the product and the process are classified in different subclasses (1.11 and 1.42, respectively), there is no requirement in the MPEP for restriction based on sub-classifications. Further, Applicant notes that the elements of stent, drug and heat are common to each of the Groups I and II.

Thus, Applicant asserts that an art search for any of the Groups I – II would be expected to yield the art that is pertinent to the patentability of each of the Groups I – II. As a result of the foregoing, Applicant asserts that the restriction of Applicant's claims is improper and should be withdrawn.

In the event that the Examiner maintains said restriction, Applicant submits herewith an amended claim set that obviates the requirement for the restriction.

ELECTION OF SPECIES

The Examiner has also required, under 35 USC §121, the election of a single disclosed species of a stent (Group I) from Species A – Species C for initial prosecution on the merits.

Although Applicant has provisionally elected Group II, in order to be fully responsive, Applicant elects the Species A of Group I (disclosed and claimed in Claims 1-5, 15-19 and 21-22) for prosecution, with traverse.

Applicant submits that in view of the claim amendments made herein to facilitate the speedy prosecution of this application, the requirement for an election of species is now obviated.

REMARKS

Claims 6-10, 20 and new claims 23-36 are currently pending in the present application. Claims 6 and 8-10 have been amended to address grammatical and/or typographical informalities, and to comply with the formality requirements. Claim 6 has been amended to include the subject matter of original claim 14 as an alternate effect. Claim 8 has been amended to properly depend from Claim 7. Claims 6 and 20 have been amended to include the “inductive” heating aspect of original claim 21. In order to facilitate the speedy prosecution of the present application, Applicant has rewritten the claim set as follows:

Claims 1-5, 11-19 and 21-22 have been canceled without prejudice. New claims 23-36 have been added. Support for new claims 23-36 may be found in the Specification, including paragraphs [0005]-[0010], [0021]-[0023], [0025]-[0026], and [0035] of the Applicant’s published application, US 20040127886, and in the originally filed claims listed below. No new matter has been added.

New Claim	Support in Original Claim(s)		New Claim	Support in Original Claim(s)
23	1, 21		30	1 and 13
24	1		31	15, 16 and 21
25	3		32	17
26	5		33	18
27	4		34	19
28	11		35	21
29	2 and 12		36	22

CONCLUSION

In view of the remarks presented herein, Applicant submits that the instant restriction and election requirements do not comply with the MPEP, the U.S. Patent Rules, or U.S. Patent Laws. As such, Applicant respectfully requests that the Examiner reconsider and withdraw such requirements.

In the event that the Examiner maintains the restriction and election requirements, Applicant submits that the Applicant is fully responsive to these requirements in view of the amendments and remarks presented herein

In the event there are remaining issues, the Examiner is invited to call Applicant's undersigned attorney to discuss such issues.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge Deposit Account No. 50-0436 for any fees that may be due in connection with this response.

Respectfully submitted,



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By: _____
Raymond A. Miller
Reg. No. 42,891

Pepper Hamilton LLP
One Mellon Center
50th Floor
500 Grant Street
Pittsburgh, PA 15219
(412) 454.5000
(412) 281-0717 - facsimile